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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,182	07/21/2006	Markus Dierker	C 2647 PCT/US	2215
23657	7590	12/30/2010	EXAMINER	
FOX ROTHSCHILD LLP 997 Lenox Drive, Bldg. #3 Lawrenceville, NJ 08648			GULLEDGE, BRIAN M	
			ART UNIT	PAPER NUMBER
			1612	
			NOTIFICATION DATE	DELIVERY MODE
			12/30/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocket@foxrothschild.com

Office Action Summary	Application No.	Applicant(s)	
	10/553,182	DIERKER ET AL.	
	Examiner	Art Unit	
	Brian Gulledge	1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-29,33 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-29,33 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Previous Rejections

Applicants' arguments, filed 19 November 2010, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 12-29 and 33 stand rejected under 35 U.S.C. 102(b) as being anticipated by Collin (US Patent 6,464,967). The Applicant argues that the rejection is not proper. The Applicant states that Collin discloses the well-known process of homopolymerizing pure α -olefins to produce a relatively narrow set of oligomeric products. Applicant states that these mixtures are clearly mixtures of α -olefin monomers that vary only in the carbon content. In contrast, the Applicant states that dehydration polymerization of a single primary alcohol provides an isomeric mixture of olefins (terminal and internal olefins), providing a product having unique cosmetic properties. Collins, on the other hand, uses only a mixture of α -olefins (terminal olefins). In a declaration filed under 37 CFR 1.132, the declarant states that pure α -olefins do not react under Applicant's reaction conditions. The Applicant then concludes that

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this demonstrates that the claimed process is a unique process producing a product substantially different from the prior-art poly- α -olefins.

The Examiner acknowledges the arguments, but does not consider them persuasive. The claims recite a cosmetic containing a mixture of poly- α -olefins produced from at least one primary alcohol by dehydrating polymerization conducted at a temperature between 60 °C and 340 °C in the presence of acidic alumino layer silicates. As stated previously, Collin discloses a cosmetic with a poly- α -olefin present, but does not recite the same process for preparing the olefinic mixture. Collin discloses using a material prepared from a mixture of α -olefins, which are then polymerized. Thus, Collin discloses all of the limitations of the instantly recited composition except for the method by which the instantly recited composition is prepared. However, the claims recite a product, and the patentability of a product does not depend on its method of production, and if the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP 2113.

The product recited is a mixture of poly- α -olefins. The product disclosed by Collin is a mixture of poly- α -olefins. So the rejection is proper if the product disclosed by Collin could have been prepared by the method instantly recited. The rejection, to be proper, does not require that the starting materials used by Collin would produce a product as claimed if subjected to the claimed reaction conditions (as argued by the declarant). The claimed process is a dehydration-polymerization. The dehydration of a primary alcohol will produce α -olefins – for example, the dehydration of 3-methyl-1-decanol (a primary alcohol) will produce 3-methyl-1-decene (an α -olefin). Thus, the claimed method prepares the olefin(s) in situ before polymerizing, whereas

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Collin discloses polymerizing the isolated olefins. In terms of the products prepared, the mixture of poly- α -olefins disclosed by Collin appears to be the same as the claimed products.

"Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product." See MPEP 2113 & In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). The Applicant has not provided any evidence to demonstrate there is a difference between the product prepared by the method used by Collin and the corresponding mixture of poly- α -olefins (same mixture of starting carbon content) prepared by the claimed process. The only evidence submitted – the declaration filed under 37 CFR 1.132 received 19 November 2010 – states that pure α -olefins do not react under Applicant's reaction conditions. However, this evidence does not distinguish the product disclosed by Collin from the claimed product, but rather is directed to a hypothetical question as to the behavior of the starting material used by Collin.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 12-29, 33, and 34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hansenne (US Patent 5,747,009) in view of PCT Patent Application Publication WO 03/035707. The above PCT publication is in a language other than English,

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and as such the English-language equivalent document Zander et al. (US patent Application Publication 2004/0267073) will be referenced to support the rationale of this rejection.

The Applicant argues that the rejection is not proper in view of the declaration filed under 37 CFR 1.132 and received 19 November 2010. The declaration states that pure α -olefins do not react under Applicant's reaction conditions. The Applicant then concludes that this demonstrates that the claimed process is a unique process producing a product substantially different from the prior-art poly- α -olefins.

The Examiner does not consider the argument persuasive. Zander et al. discloses poly- α -olefins produced by the exact method recited by the instant claims. This fact rebuts Applicant's assertion that the process is unique and that the poly- α -olefin product claimed is unique. Furthermore, it is entirely unclear to the Examiner how the statement regarding starting materials ("pure α -olefins") that are unrelated to the starting material used by Zander (primary alcohols) rebuts the rejection. Zander clearly teaches poly- α -olefins that prepared according to the same method claimed, and not a process using "pure α -olefins."

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Gulledge whose telephone number is (571) 270-5756. The examiner can normally be reached on Monday-Thursday 6:00am - 3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gollamudi S Kishore/
Primary Examiner, Art Unit 1612

BMG